

RECEIVED
CENTRAL FAX CENTER
OCT 13 2004

Facsimile

Please deliver immediately

160 Elgin Street
Suite 2600
Ottawa, Ontario
Canada K1P 1C3
Telephone (613) 233-1781
Facsimile (613) 563-9869Dallas Smith
Direct Dial (613) 783-8827
Dallas.Smith@gowlings.com

To Jean D. Janvier

Firm UNITED STATES PATENT OFFICE

City/Country Arlington, VA

Fax 703-872-9306

Telephone 703-308-6287

Date Wednesday October 13, 2004

Re United States Patent Application No. 09/808,170 Filed March 15, 2001
Method And Apparatus For Location Dependent Software Applications
Our Reference : 08890794US

Total Pages Sent (including cover memorandum) 5

CopyTrak # 1981

Enclosed please find our Response to Official Action dated September 13, 2004.

If there is a problem with transmission or all pages are not received, please call Julie Quesnel at (613) 233-1781 x57523 for retransmission. This message is intended only for the use of the individual or entity to which it is addressed, and may contain information that is privileged, confidential and exempt from disclosure under applicable law. If the reader of this message is not the intended recipient, or the employee or agent responsible for delivering the message to the intended recipient, you are hereby notified that any dissemination, distribution or copying of this communication is strictly prohibited. If you have received this communication in error, please notify us immediately by telephone (call us collect), and return the original to us by postal service at the address noted above. Thank you.

Montreal

Ottawa

Toronto

Hamilton

Waterloo

Calgary

Vancouver

Moscow

RECEIVED
CENTRAL FAX CENTER

OCT 13 2004

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In The Matter of United States Patent Application:

Serial No. : 09/808,170
Filed : March 15, 2001
Group Art Unit : 3622
Examiner : Jean D. Janvier
Title : Method And Apparatus For Location Dependent Software Applications
Our File : 08890794US
Date : October 13, 2004

Commissioner of Patents and Trademarks
P.O. Box 1450
Alexandria, Virginia
United States of America

Response to Restriction Requirement

Dear Sirs:

The Official Action mailed September 13, 2004, has been received and carefully noted. The following remarks are submitted as a full and complete response thereto.

The Office Action contained a restriction requirement, requesting election between two allegedly separate inventions, which the Examiner identified as Group I (claims 1 – 10 and 19 – 20) and Group II (claims 11 – 18).

The Applicant respectfully elects to prosecute the subject matter of Group I (claims 1 – 10 and 19 – 20), but also wishes to object to the restriction requirement. The Applicant submits that the restriction requirement is improper and should be withdrawn, in view of the following.

The Applicant understands that Section 800 of the Manual of Patent Examination Procedure (MPEP) governs the restriction of claims. As noted in Section 802.1 of the MPEP, 35 U.S.C. 121 states that the Commissioner may require restriction if two or more "Independent and distinct" (emphasis added)

inventions are claimed in one application. Thus, if it can be shown that two groups of claims not independent from one another, OR are not distinct from one another, the restriction request fails.

The term "independent" is defined in Section 802.1 as follows: "The term 'independent' (i.e., not dependent) means that there is no disclosed relationship between the two or more subjects disclosed, that is, they are **unconnected in design, operation, or effect ...**" (emphasis added). The term "Distinct" is also defined in this section of the MPEP, as follows: "The term 'distinct' means that two or more subjects as disclosed are related, for example, as combination and part ... and are **patentable (novel and unobvious) over each other ...**" (emphasis added).

The Applicant submits that the Examiner's request for election/restriction fails because it satisfies neither of the two necessary conditions (Independence and distinctness); again, it is necessary that **both** of the conditions be satisfied for restriction to be required. The Applicant will demonstrate this with respect to the independent claims 1 and 11, which appear in claim Groups I and II respectively.

With regard to the question of "independence", clearly the claims at issue are not "unconnected in design, operation, or effect". In both cases, the method begins with an end user sending a request for a web page, via his ISP. This request is processed, and a response returned to the end user, again (of course), via his ISP. In both cases, this response is generated with consideration for the **location** of the ISP itself.

All of these limitations are common to both of claims 1 and 11, though the explicitness of these limitations might vary. The only significant difference between these two claims is that claim 1 describes the invention in the context of a gaming application, while claim 11 is more generic, referring to any manner of "targeted content". That is, in the case of claim 11, any content that is returned

to the end user can be tailored (or "targeted") to the location of the end user's ISP. In the case of a gaming application, it may be determined that the end user is in an unacceptable geographic location, so the "targeted content" may consist of a rejection of the end user's attempt to access the gaming server. Claims 12 – 17 are directed to an advertising application, but clearly claim 11 is not limited in this way.

Because claims 1 and 11 share the same major limitations, they cannot be said to be "unconnected in design, operation, or effect ...". Hence, the two groups of claims could not be said to be "independent" of one another as defined under Section 800 of the MPEP.

The Applicant does not agree that the claim groupings are "distinct" either.

The Applicant notes that Section 806.05(c) of the MPEP reads "In order to establish that combination and subcombination inventions are distinct, **two-way distinctness must be demonstrated.**" (emphasis added) The Examiner has asserted that "the combination does not require, as shown above, the particulars of the subcombination". The Applicant submits that, at the very least, the inverse is not true. If the inverse is not true, then "two-way distinctiveness" has not been shown, and Section 806.05(c) of the MPEP has not been satisfied.

The Applicant also notes that 37 CFR 1.141 explicitly accommodates the claims of the subject application in a single patent, as it reads that: "... more than one species of an invention, not to exceed a reasonable number, may be specifically claimed in different claims in one national application ...". Surely, having two specifics (advertising and gaming applications) in a single patent application could not be considered to be an unreasonable number of specifics. The Applicant has simply claimed the same invention from different perspectives in an attempt to capture the full breadth of the invention. The Applicant is clearly entitled to this breadth under the law.

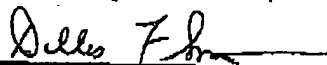
Hence, the Applicant submits that the two groups of claims are not "distinct", and that the restriction request is therefore incorrect.

To reiterate, the Applicant understands that a restriction requirement is only valid where it can be shown that the groups of claims are both "independent" and "distinct". In this case, the Applicant submits that neither has been shown, and therefore asks that this objection be withdrawn.

In the event that the Examiner is not persuaded by these arguments, the Applicant wishes for examination to proceed with Group I (claims 1 - 10 and 19 - 20). The Applicant reserves the right to file divisional/continuation applications to pursue the balance of the claims.

In the event that this paper is not being timely filed, the Applicant respectfully petition for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-1644.

Respectfully submitted,



Dallas Smith
Registration No. 34,074

Gowling Lafleur Henderson LLP
160 Elgin Street, Suite 2600
Ottawa, Ontario
Canada K1P 1C3
(613) 233-1781

Doc #879625 v1